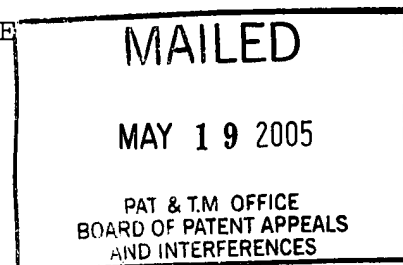


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
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Ex parte WALTER HORBURGER and WOLFGANG SCHEYER

\_\_\_\_\_  
Appeal No. 2005-1042  
Application No. 09/759,543  
\_\_\_\_\_

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ON BRIEF  
\_\_\_\_\_

Before KIMLIN, GARRIS, and PAK, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-5.

The subject matter on appeal relates to a level comprising a level body made of a foamed metal. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

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1. A level comprising a level body and at least one bubble level mounted in the level body, wherein the level body is of a foamed metal.

The references relied upon by the examiner as evidence of obviousness are:

Niebylski et al. (Niebylski)	3,873,392	Mar. 25, 1975
Provi	3,889,353	Jun. 17, 1975
Patten	4,099,961	Jul. 11, 1978
Richardson et al. (Richardson)	5,607,181	Mar. 4, 1997
Goss et al. (Goss)	5,749,152	May 12, 1998
Brungs	6,332,907	Dec. 25, 2001

(effective filing date Aug. 8, 1998)

The appealed claims are rejected as follows under 35 U.S.C. § 103(a):

Claim 1 is rejected over Goss in view of Patten;

Claim 4 is rejected over Goss in view of Patten and further in view of Provi;

Claims 1 and 2 are rejected over Goss in view of Brungs;

Claims 1-3 and 5 are rejected over Goss in view of Niebylski; and

Claim 3 is rejected over Goss in view of Richardson.

On page 4 of the brief, the appellants state that "[c]laims 2 to 5 stand or fall with claim 1." Consistent with this statement, the brief contains no separate arguments regarding any of appealed dependent claims 2-5. Under these circumstances, we will focus on appealed claim 1 which is the sole independent

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claim before us in assessing the merits of the above noted rejections.

We refer to the brief and to the answer for a complete discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning these rejections.

#### OPINION

We cannot sustain the examiner's rejection of claim 3 as being unpatentable over Goss in view of Richardson. However, we will sustain each of the other rejections advanced on this appeal. Our reasons follow.

According to the examiner:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the level/article, disclosed by Goss, of a synthetic coated foamed aluminum, as taught by Richardson, so as to have a light weighted, durable level less susceptible to the harsh environment with the porous structure protected inside from possible contamination and moisture, in order to maintain accuracy and longevity of the device [answer, pages 5-6].

While Richardson may disclose a synthetic coated foamed aluminum as indicated by the examiner, this disclosure is in the context of an inflator device for a vehicle air bag system. There is utterly nothing in Richardson's disclosure which would have suggested using a synthetic coated foamed aluminum as a material

of construction for the level of Goss. The examiner's contrary viewpoint is unquestionably based upon impermissible hindsight.

In light of the foregoing, the section 103 rejection of claim 3 over Goss in view of Richardson cannot be sustained.<sup>1</sup>

Regarding the rejection of claim 1 over Goss in view of Patten, we share the examiner's conclusion that it would have been obvious for one having ordinary skill in the art to manufacture Goss's level housing from foamed metals of the type taught by Patten. In this way, the solid housing material shown in Figure 2 of Goss would have been replaced by a foamed metal material of the type and having the benefits (e.g., lighter weight or lesser density) taught by Patten, for example, at lines 17-39 in column 1. Contrary to the appellants' belief and argument, an artisan would have been motivated to so combine these reference teachings in order to obtain the aforementioned benefits.

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<sup>1</sup> For unknown reasons, the examiner has applied this rejection against dependent claim 3 only and thus has made no express rejection or obviousness conclusion with respect to parent independent claim 1. Because a dependent claim includes all the limitations of the parent claim (see 37 CFR § 1.75(c)), this practice is wholly inappropriate. We advise the examiner and her two SPE conferees to discontinue such practice immediately.

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In this latter regard, the appellants argue that, "since the present invention does not have the objective of providing a lighter level, the motivation to combine the [Goss and Patten] references to provide a lighter weight level as argued by the Examiner is of no relevance to the present invention" (brief, page 6). This argument is inconsistent with established legal principle and therefore is unpersuasive. Notwithstanding the appellants' aforequoted viewpoint, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

Under these circumstances, it is our determination that the reference evidence adduced by the examiner establishes a prima facie case of obviousness which the appellants have failed to successfully rebut with argument or evidence of nonobviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We hereby sustain, therefore, the examiner's section 103 rejection of claim 1 as being unpatentable over Goss in view of Patten.

As for the Provi reference and the corresponding rejection of claim 4, the appellants' only comment is that Provi does "not come closer to the presently claimed invention than the [Goss and Patten] references discussed above and thus any detailed comments thereon would be superfluous" (brief, page 8). As reflected by our discussion above, however, we consider Goss and Patten to evince a prima facie case of obviousness with respect to appealed independent claim 1. For this reason and because dependent claim 4 has not been separately argued with any reasonable specificity, we also hereby sustain the section 103 rejection of claim 4 as being unpatentable over Goss in view Patten and further in view of Provi.<sup>2</sup>

Our study of the applied references leads us to conclude that it would have been obvious for an artisan to replace the solid housing material of Goss's level with a foamed metal material in order to obtain the benefits taught by Brungs (e.g., see the paragraph bridging columns 3 and 4 as well as lines 3-32 in column 5). The appellants' arguments in opposition to this conclusion of obviousness are unpersuasive for reasons analogous

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<sup>2</sup> As a matter of interest, we point out that the Provi reference does not appear to be necessary in this rejection of claim 4. This is because the recess feature of claim 4 is clearly disclosed by Goss (e.g., see Figure 2 and the corresponding narrative disclosure).

to those previously advanced. Accordingly, we also hereby sustain the section 103 rejection of claims 1 and 2 as being unpatentable over Goss in view of Brungs.

Finally, the Niebylski reference evinces that foamed metals are known in the prior art as materials of construction (e.g., see the discussion of prior art at lines 15-32 in column 1). Indeed, the appellants acknowledge as much in their discussion of prior art on specification pages 4 and 7.<sup>3</sup> Because the prior art recognizes the use of foamed metals in constructing articles of manufacture and concomitantly recognizes the benefits which attend this use, it is appropriate to conclude that an artisan would have found it obvious to use foamed metals in constructing Goss's level housing in order to obtain the advantages associated with foamed metals by the prior art as evinced, for example, by the Niebylski reference. The appellants' nonobvious arguments (e.g., see the paragraph pages 7 and 8 of the brief) correspond

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<sup>3</sup> It is axiomatic that admitted prior art in an applicant's specification may be used in determining the patentability of a claimed invention (In re Nomiya, 509 F.2d 566, 570-71, 184 USPQ 607, 611-12 (CCPA 1975)) and that consideration of the prior art cited by the examiner may include consideration of the admitted prior art found in an applicant's specification (In re Davis, 305 F.2d 501, 503, 134 USPQ 256, 258 (CCPA 1962); compare In re Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986)).

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to those addressed earlier and remain unpersuasive for the reasons previously explained.

As a consequence, we hereby sustain the section 103 rejection of claims 1-3 and 5 as being unpatentable over Goss in view of Niebylski.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Edward C. Kimlin  
Administrative Patent Judge

Bradley R. Garriss  
Administrative Patent Judge

  
Chung K. Pak  
Administrative Patent Judge

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